



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/799,234

03/12/2004

Trent A. Shidaker

WUR 50656/USw/2

7528

62068 7590 09/25/2008
HUNTSMAN INTERNATIONAL LLC
LEGAL DEPARTMENT
10003 WOODLOCH FOREST DRIVE
THE WOODLANDS, TX 77380

EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

09/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/799,234	Applicant(s) SHIDAKER ET AL.	
	Examiner Rabon Sergent	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper | |

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 18, 2008 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1 and 3-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dempsey et al. ('696) in view of Parks et al. ('176) or Mackey ('553 or '528) and further in view of Gillis et al. ('107 or '939).

Dempsey et al. disclose the production of molded polyurethane products, including SRIM products, wherein an internal mold release agent comprising fatty polyesters, that correspond to applicants' claimed fatty polyester, is utilized with a polysiloxane surfactant that corresponds to

Art Unit: 1796

applicants' claimed poly(dimethylsiloxane)-polyoxyethylene surfactant. Dempsey et al. disclose this surfactant as L-6980. See example 1. Dempsey et al. further teach at column 8, line 16 that surfactants corresponding to those of applicants are preferred components of the composition. It is noted that applicants have amended the EO content per 100 g of the polymer to at least about 0.006 moles; accordingly, the following position are taken. Firstly, in view of the "about" language, the position is taken that the amount of EO claimed meets that disclosed within example 1. This position is supported by the showings within applicants' declaration of January 25, 2007, wherein it has been established that the EO mole content is as high as 0.0053. Secondly, even if it is determined that the EO amount within claim 1 is higher than that of example 1, the position is taken that that the exemplified content is so close to that claimed, that one of ordinary skill would have reasonably expected the respective compositions to display the same properties. The logic for this position stems from the rationale set forth within the court decision, *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). This position is bolstered by applicants' own Example 6, which shows that an EO content of 0.0052 moles per 100 grams of polymer yielded good mold release properties.

4. Dempsey et al. fail to disclose applicants' component c)ii), fatty acid; however, applicants' specifically claimed mold release agent comprising both a fatty polyester and a fatty acid were known to be useful internal mold release agents for RIM and SRIM polyurethane moldings at the time of invention. This position is supported by the teachings of Parks et al. and Mackey. Parks et al. disclose applicants' claimed internal mold release agent within the abstract; column 2; and column 3, lines 1-46. Mackey discloses applicants' claimed internal mold release agent within the abstract and columns 3 and 4. The references further disclose the use of

Art Unit: 1796

surfactants. See column 7, lines 30-47 within Parks et al. See column 9, lines 18-20 within Mackey.

5. Since it has been held that it is *prima facie* obvious to utilize a known component for its known function and in view of the teachings within Parks et al. and Mackey to utilize a fatty acid component in admixture with a fatty polyester component to produce mold release compositions for SRIM polyurethane moldings, the position is taken that it would have been obvious to incorporate the claimed fatty acid into the mold release agent composition of Dempsey et al., so as to arrive at the instant invention. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

6. Furthermore, Gillis et al. disclose that the combination of polysiloxane surfactants with mold release agents comprising a fatty acid ester component yields a synergistic result in terms of the effectiveness of the mold release property in SRIM systems. See column 2, line 55. While Gillis et al. fail to specifically disclose applicants' claimed surfactant and mold release agent, the position is taken that, since each of the disclosed mold release agents within Dempsey et al., Parks et al., and Mackey is derived from long chain fatty compounds, the mold release agents of these references are analogous to the mold release agent of Gillis et al. to the extent that one of ordinary skill would have expected them to yield comparable release properties to that of Gillis et al. Accordingly, one would have reasonably expected that the combined use of fatty compound based release agents and polysiloxanes would yield SRIM compositions having improved mold release, relative to compositions not employing these respective components in combination. Furthermore, since mold release properties have been linked to the polysiloxane surfactant, it stands to reason that increasing the amount of the polysiloxane surfactant would be

Art Unit: 1796

expected to improve mold release properties; therefore, it would have been obvious to increase the amount of polysiloxane surfactant utilized thereby increasing the EO content contributed by the surfactant. It has been established that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

7. Applicants' response has been considered; however, the response fails to overcome the prior art rejection for the following reasons. Firstly, applicants have argued that their results are superior to anything that one might expect from studying prior art compositions. In response, applicants have not clearly elaborated on this position; without further discussion, it is by no means clear that the argued results are representative of the prior art. In other words, it not clear that a side by side comparison of applicants' invention to the prior art has been set forth. Secondly, in response to the examiner's position set forth within paragraph 3, applicants state that the composition of Example 6 does not achieve the unexpectedly superior results of the claimed compositions. However, this argument is untenable, because applicants' Example 10 is clearly representative of the claimed invention yet yields fewer releases than Example 6.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

/Rabon Sergent/
Primary Examiner, Art Unit 1796

R. Sergent
September 21, 2008